

**RECEIVED
CENTRAL FAX CENTER**

MAR 07 2006

Docket No.: VOSS-P01-007
(PATENT)

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.	
Dated: <u>March 7, 2006</u>	Signature:  (Mary Jane DiPalma)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Pessara *et al.*

Confirmation No.: 3295

Application No.: 10/773,100

Art Unit: 1631

Filed: February 5, 2004

Examiner: Whaley, Pablo S.

For: HIGH-THROUGHPUT DNA-ISOLATION
AND TRANSFECTION FOR ANALYSING
THE FUNCTION OF GENES OR GENETIC
PRODUCTS

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This response is filed in reply to the outstanding Restriction Requirement, mailed on December 9, 2005, in connection with the above application. The period for response has been extended to March 9, 2006, by the accompanying petition for TWO-month extension. Applicants hereby elect Group I, Claims 1-28, *with traverse*, on the following grounds.

Applicants traverse this restriction requirement on the basis that Groups I - IV are so closely related and they share common features that would facilitate searching all groups at once. For example, Groups II - IV claims are dependent claims of the elected Group I claims. Therefore, a search and examination of all pending claims can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Regarding the species election, Applicants hereby provisionally elect, *for search purpose only*, the following species, *with traverse*:

9951845_1

- 1 -

Application No.: 10/773100

Docket No.: VOSS-P01-007

- (1) Species A: cDNA molecules; currently, all claims read on the elected species;
- (2) Species B: screening for the function of a secreted protein; currently, all claims read on the elected species;
- (3) Species C: calcium phosphate transfection; currently, all claims read on the elected species.

Applicants respectfully remind the Examiner that the correct wording in Claim 26 is “screening for the function of a secreted protein,” rather than the “screening for *the secretion of a protein*” as incorrectly recited in the Restriction Requirement. Applicants respectfully request that the correct wording as found in Claim 26 be used as the basis for any search.

Applicants elect these species with traverse on several grounds.

First of all, Applicants note that at least Claims 1 and 2 are generic claims linking elected and non-elected species. Claims 3, 16, and 26 are dependent claims of Claims 1 and 2 including all limitations of the generic Claims 1 and 2. Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

Secondly, Applicants submit that species subjected to species election are encompassed by Markush groups. Pursuant to MPEP 803.02, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even

9951845_1

Application No.: 10/773100

Docket No.: VOSS-P01-007

though they are directed to independent and distinct inventions." Applicants submit that such is the case in all the species elections. Thus all listed species can be examined simultaneously without significant additional burden on the Examiner. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

Lastly, Applicants note that Claims 3, 16, and 26 are generic claims encompassing all elected and non-elected species. Restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809).

These elections are made expressly without waiver of applicants' rights to continue to prosecute and to obtain claims to the non-elected subject matter either in this application or in other applications claiming priority herefrom.

Enclosed is a two-month petition for extension of time and payment of the required fee. Applicant believes no further fees are due with this response. However, if any further fees are due, please charge our Deposit Account No. 18-1945, under Order No. VOSS-P01-007 from which the undersigned is authorized to draw.

Dated: March 7, 2006

Respectfully submitted,

By _____

Yu Lu, Ph.D.

Registration No.: 50,306
ROPES & GRAY LLP
One International Place
Boston, Massachusetts 02110-2624
(617) 951-7000
(617) 951-7050 (Fax)
Attorneys/Agents For Applicant

9951845_1

- 3 -